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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,744	10/18/2001	David A. Witt	END-796	7848

27777 7590 02/26/2004
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NEW BRUNSWICK, NJ 08933-7003

EXAMINER

WOO, JULIAN W

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,744

Applicant(s)

WITT ET AL.

Examiner

Julian W. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9, 13 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 5-7, 10-12 and 14-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informality: In the "Background of the Invention," where related patent applications are cited, attorney docket numbers are cited instead. The specification should be updated with U.S. patent application and patent numbers, including the present application's relation to application numbers 09/644,991 and 09/412,557. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Tsonton et al. (5,944,737). Tsonton et al. disclose, in figures 1-4, an ultrasonic clamp coagulator

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apparatus comprising a housing (130), an ultrasonic waveguide (180) with an end effector (180'), a clamp means (190), and an actuator (220).

4. Claims 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Tovey et al. (5,489,292). Tovey et al. disclose, in figures 20 and 23, a clamp arm with curved surfaces, a proximal end and a distal end, a top surface with at least one hole and a bottom surface with at least one engaging surface, where each hole extends from the top surface to the engaging surface. Note: The introductory statement of intended use ("for use with an ultrasonic instrument") has been carefully considered but deemed not to impose any structural limitations on the claims patentably distinguishable over the device of Tovey et al., which is capable of being used as claimed if one desires to do so.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-4, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsonton et al. (5,944,737) in view of Tovey et al. (5,489,292). Tsonton et al. disclose the invention substantially as claimed. Tsonton et al. disclose, in figures 1-4 and in col. 9, line 4 to col. 10, line 56, an ultrasonic clamp coagulator apparatus comprising a housing (130), an ultrasonic waveguide (180) with an end effector (180'), outer and inner tubes (160, 170), a clamp arm (190) having a curved top surface and a bottom surface with a plurality of engaging surfaces (192), and an actuating element (220). However, Tsonton et al. do not disclose at least one hole or slot extending from the top surface to the bottom surface. Tovey et al. teach, in figures 20 and 23, a clamp arm with a plurality of holes or straight slots extending from a top surface to a bottom surface with engaging surfaces (222). It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Tovey et al., to include holes or slots in the clamping arm of Tsonton et al. Such holes or slots would enhance the tissue gripping properties of the clamp arm.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tovey et al. (5,489,292). Tovey et al. disclose the invention substantially as claimed. Tovey discloses, in figure 24, a clamp arm with a plurality of depressions staggered laterally from the proximal end of the clamp arm to the distal end of the clamp arm. However, Tovey et al. do not disclose a curved clamp arm with a plurality of holes staggered laterally from the proximal end of the clamp arm to the distal end of the clamping arm. Nevertheless, Tovey et al. disclose, in col 13, lines 60-67, that depending on the desired degree of tissue gripping enhancement of the clamp arm, one may include depressions

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or holes. Thus, it would have been a matter of design choice to one having ordinary skill in the art at the time the invention was made, to modify the clamp arm, so that it has a plurality of holes rather than the depressions. Holes would allow the clamp arm to receive more tissue, as compared to tissue received in depressions, in order to enhance the gripping capability of the clamp arm.

Allowable Subject Matter

8. Claims 5-7, 10-12, and 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art of record, alone or in combination, discloses an ultrasonic clamp coagulator with, inter alia, a housing, a waveguide, and a clamp arm with a slot extending from the proximal end of the clamp arm distally into the clamp arm, where the slot is straight from the proximal end of the clamp arm to the most proximal of a plurality of holes in the clamp arm, where the holes extend from a top surface to a bottom surface of the clamp arm.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Springer (3,404,677) and Aranyi et al. (5,509,922) teach clamp arms with holes or slots.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (703) 308-0421. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached at (703) 308-2496.

General inquiries relating to the status of this application should be directed to the Group receptionist at (703) 308-0858. The official FAX number is (703) 872-9306.



Julian W. Woo
Primary Examiner

February 20, 2004